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INTELLECTUAL PROPERTY LAW DEPARTMENT
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AUSTIN, TEXAS 78758
FAX # 512

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SEND TO: United States Patent Office

Examiner: P. J. SmithGroup Art Unit: 2176Tel No: 703-571-272-4101Fax #: 703-872-9306FROM: J. B. KRAFTTel No: 512-473-2307

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Docket No. AUS920000234US1 Serial No. 09/589,666 Atty: J. B. KRAFTApplicant: B. S. Baweja et al

<input type="checkbox"/> Transmittal Letter (2 copies)	<input type="checkbox"/> Certificate of Facsimile
<input type="checkbox"/> Preliminary Amendment	<input type="checkbox"/> Notice of Appeal
<input type="checkbox"/> Amendment AF	<input type="checkbox"/> Appeal Brief (3 copies)
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Response to Non-Compliance Notice

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : Group Art Unit: 2176
: Examiner: P. J. Smith
Balijeet S. Baweja et al. : Intellectual Property
Serial No: 09/589,666 : Law Department - 4054
Filed: 06/08/2000 : International Business
Title: DISTRIBUTING CONDENSED : Machines Corporation
VERSIONS OF DISPLAYABLE : 11400 Burnet Road
INFORMATION IN HYPERTEXT : Austin, Texas 78758
MARKUP LANGUAGE DOCUMENTS :
TRANSMITTED ON THE WORLD WIDE :
WEB TO PERSONAL PALM-TYPE :
DISPLAY COMPUTERS :
Date: 12/22/04 :

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence including The present Amendment and an accompanying Transmittal letter is being transmitted via facsimile to USPTO, Group Art Unit 2176 at telephone number 703-872-9306, and to the attention of Examiner P. J. Smith on 12/22/04.

J.B. KRAFT

Signature

Date

RESPONSE TO NON-COMPLIANCE NOTICE

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

In response to the Notice mailed December 7, 2004,

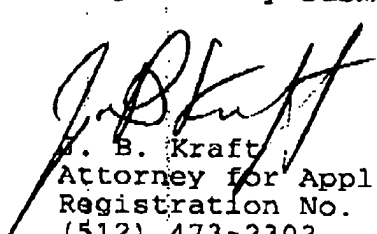
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attached are copies of pages 13 and 14 from the Response of
July 16, 2004 which failed to properly transmit.

Respectfully submitted,


J. B. Kraft
Attorney for Applicants
Registration No. 19,226
(512) 473-2303

ALL CORRESPONDENCE SHOULD BE DIRECTED TO:

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Austin, Texas 78758

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the specific needs of users referred to as Advice Consumers of clients. This is carried out by a sophisticated system of intelligent servers which serve as agents for the advice consumers. In this extensive general disclosure which is not related to the present invention, the Examiner has extracted a segment at col 22, lines 15-22 which appears to only be pertinent if interpreted in light of Applicants' own teaching. There is a general statement of an E-mail message with alternative versions the selection of which is determined by the destination. When read in the light of Donoho's teaching, this only means that Donoho's interpretive servers can select the appropriate version suitable to the needs of the advice consumer. There still is no suggestion of the element of the present invention wherein there are means in the personal palm-type computer for directly accessing the second i.e. condensed version of the displayable data from the received markup language document.

Applicants submit that such a proposed combination of references is being made not with the requisite foresight of one skilled in the art, but rather with the hindsight obtained solely by the teaching of the present invention. This approach cannot be used to render Applicants' invention unpatentable.

What the Examiner has done is used Applicants' disclosure as a guideline, and the picked and combined elements from each of the kikinis and Donoho references based solely of Applicants' teaching.

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art references of record convey nor suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its

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teacher." W. L. Gore, 721 F 2d at 1553, 220 USPQ,
pp. 312-313.

"One cannot use hindsight reconstruction to
pick and choose among isolated disclosures in the
prior art to deprecate the claimed invention." In
re Fine, 5 USPQ 2d 1596 (C.A.F.C.) 1988.

Accordingly, it is submitted that the suggestion for
combining Kikinis with Donoho in the manner proposed by the
Examiner could only come from Applicants' own teaching, and,
thus, cannot form any basis for a combination of references.

Claims 4-8, 10-13, 15-18, 20, 22, and 24 include the
further elements of a first and a second set of tags in each
HTML document respectively identifying the two data set
versions of the same content. Kikinis or Donoho contain
nothing equivalent to such identifying tags.

In view of the foregoing, claims 4-18 and 23-34 are
submitted to be in condition for allowance, and such
allowance is respectfully requested.

Respectfully submitted,

/s/ J.B. Kraft

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